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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,472	07/09/2001	Peter K. Kassab	3404 P 005	6545

7590 09/25/2003
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EXAMINER

MAKI, STEVEN D

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,472

Applicant(s)

KASSAB, PETER K.

Examiner

Steven D. Maki

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

Art Unit: 1733

- 1) The disclosure is objected to because of the following informalities: Page 7 line 15 of the specification refers to claim 2. The reference to claim 2 should be deleted.

Appropriate correction is required.

- 2) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3) Claims 1-11, 13, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the scope of claim 1 is unclear because it is unclear if (1) the first side of the film is fixedly attached to the sticker using the adhesive or (2) the first side of the vinyl film is adapted to be releasably adhered to a receiving surface.

In claim 4 line 4, "there" should be --thereon--.

In claim 6, it is unclear if this claim requires a sticker assembly for a vehicle having a window or a sticker assembly on a window of a vehicle. In claim 6 next to last line, it is suggested to change "adhered" to --adhereable--.

In claim 11, it is unclear how many second side(s) are being claimed. In claim 11 four lines from bottom, "the second sides" should be --the second side--.

In claim 13 line 15, there is no antecedent basis for "the second strip of static-cling film". In claim 13 line 15, it is suggested to change "the second strip of static cling film" to --the second strip of vinyl film--.

Art Unit: 1733

In claim 20, it is unclear if this claim requires a sticker assembly for a vehicle having a window or a sticker assembly on a window of a vehicle. In claim 20 three lines from bottom, it is suggested to change "adhered" to --adhereable--.

4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Great Britain '256 (static cling)

6) **Claims 15-16 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain '256 (GB 2217256).**

Great Britain '256 discloses a sticker assembly comprising:

a printed sheet wherein the sheet is paper, metal foil or polymer film;

an intermediate adhesive;

a non-perforated PVC cling film.

The sticker assembly is formed by bonding the printed sheet to the PVC cling film using the intermediate adhesive. The sticker assembly can releasably adhere to a vehicle window because the PVC cling film can cling to a window due to electrostatic forces.

Art Unit: 1733

The PVC cling film is transparent so that the printing of sticker assembly can be viewed right through the glass of the window.

As to claims 15, 20 and 21, the claimed static-cling sticker assembly is anticipated by the sticker assembly of Great Britain '256. As to claims 16 and 19, note Great Britain '256's teaching to form the sticker assembly by lamination.

7) Claims 15-16 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain '256 (GB 2217256) in view of Great Britain '551 (GB 2231551).

Claims 15, 16, 19, 20 and 21 are considered to be anticipated by Great Britain '256. In any event: As to claims 15, 16, 19, 20 and 21, it would have been obvious to one of ordinary skill in the art to laminate the printed sheet to the PVC cling film using an intermediate adhesive such that the adhesive directly contacts the PVC film and the "fixedly" attaches the printed sheet to the PVC film since (1) Great Britain '256 suggests laminating the printed sheet to the PVC cling film using adhesive and (2) Great Britain '551 suggests laminating a printed sheet having an adhesive layer thereon to a vinyl cling film such that the printed sheet is "positively" adhered to the vinyl cling film.

As to claim 19, Great Britain '256 suggests using a transparent PVC cling film.

As to claim 21, Great Britain '256 suggests aligning the edges of the printed sheet and PVC cling film.

8) Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain '256 (GB 2217256) in view of Great Britain '551 (GB 2231551) as

Art Unit: 1733

applied above and further in view of Gladden (US Statutory Invention Registration H46).

As to claim 17, it would have been obvious to trim the PVC cling film of Great Britain '256 as claimed since it is conventional in the bonding art to adhere two layers together and trim the edges of one of the layers so that the edges of the layers are in registry as evidenced for example by Gladden.

German '696

9) **Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Japan '014 (JP 9-97014) and optionally further in view of at least one the admitted prior art (specification pages 1-2, page 18 lines 12-17), Great Britain '233 (GB 2174233) and Langen (US 5290067).**

German '696, directed to a sticker for a car window, discloses sticking a "sticker" on a "window sticker removing aid". The window sticker removing aid consists of a "transparent foil" (transparent film), which has a "sticky layer" on one side. The adhesive force of the sticky layer is lower than the adhesive force of the sticker. Hence, German '696 discloses a **sticker assembly** comprising:

sticker for car window

transparent film

adhesive layer (sticky layer)

wherein the adhesive force of the adhesive layer is lower than the adhesive force of the sticker. German '696 teaches that the sticker assembly *allows easy and complete removal of the sticker from the window*. German '696's sticker assembly, therefore, is

Art Unit: 1733

adapted to be releasably adhered to the car window. Hence, German '696 substantially discloses the claimed invention. German '696 is silent as to the transparent film being a vinyl film.

As to claim 1, it would have been obvious to one of ordinary skill in the art to use vinyl for the transparent film of German '696 since vinyl is a known transparent resin to one of ordinary skill in the sticker art as evidenced for example by Japan '014..

As to the "adhesive": One of ordinary skill in the art would readily appreciate that German '696's sticker has an adhesive coating on one side. In any event: It would have been obvious to one of ordinary skill in the art to use a sticker having a strong adhesive as the sticker of German '696 such that the strong adhesive is in direct contact with the film and fixedly attaches the sticker to the film since (a) German '696, directed to the sticker art, teaches directly adhering a sticker on transparent film such that the adhesive force of the sticker is greater than the adhesive force of the sticky layer of the window sticker removing aid and (2) a sticker for a car window having a strong adhesive on one side for permanent bonding is well known per se in the sticker art as evidenced by the admitted prior art. Hence, German '696 suggests strongly bonding a sticker to the surface of a window removing aid and the admitted prior art teaches using a strong adhesive on a sticker for strongly bonding the sticker on a surface. In other words, one of ordinary skill in the art would readily appreciate from German '696 and the admitted prior art that an adhesive is / should be used between the sticker and the transparent film to obtain the desired "sticking". It is acknowledged that the admitted prior art

Art Unit: 1733

discloses directly sticking the sticker to the window. However, German '696 teaches sticking the sticker directly on the window sticker removing aid.

As to the "low tack adhesive layer": See sticky layer having low adhesive force in German '696. In any event: The limitation of the adhesive layer being low tack would have been obvious to one of ordinary skill in the art in view of (1) German '696's teaching that the adhesive force of the sticky layer is lower than the adhesive force of the sticker so that the adhesive assembly may be easily removed from the window and optionally (2) Great Britain '233's teaching to use an adhesive having a "lesser degree of adhesion" so a sticker assembly can be removed from a window and/or Langen's teaching to use a repositionable adhesive, such as that manufactured by 3M for Post-It® notes, for a sticker for a window so that the sticker may be removed from the window without leaving adhesive residue on the window. German '696, the optional Great Britain '233 and the optional Langen share the common subject matter of a sticker assembly for a window comprising two different adhesives wherein the adhesive for adhering the sticker to the window has a sufficiently low adhesive force to allow removal from the window. In Great Britain '233, the adhesive for fixedly attaching is between a transparent film 10 and an indicia bearing layer 13 and the adhesive permitting removal of the sticker assembly from the window is on the transparent film 10. See figure 9 of Great Britain '233. In Langen, the adhesive for fixedly attaching (the permanent adhesive 35) is between label stock 34 and label 12 whereas the adhesive for permitting removal of the sticker assembly from the window (the repositionable adhesive 36) is on the label stock 34. See figure 3 of Langen.

Art Unit: 1733

As to the indicia bearing surface being viewable through a receiving surface, one of ordinary skill in the art would readily understand that the sticker of German '696 has indicia viewable through a receiving surface since the sticker assembly of German '696 is for a car window. In other words, one of ordinary skill in the art would readily appreciate that the foil (film) is transparent in German '233 so that the sticker - including any indicia thereon- can be viewed through the transparent film and the window. In any event: It would have been obvious to one of ordinary skill in the art to provide the sticker of German '696's sticker assembly with an indicia bearing surface such that it can be viewed through a receiving surface in view of the admitted prior art's suggestion to view indicia of a sticker through the vehicle window and /or Great Britain '233's suggestion to view indicia (e.g. wording on item 13) of a sticker assembly through both the transparent film 10 of the sticker assembly and a vehicle window.

As to non-perforated: German '696 and the optional Great Britain '233 suggest using a non-perforated / continuous, uninterrupted transparent film.

As to claim 2 (method), note German '696's teaching to adhere the sticker to the window sticker removal aid to form a sticker assembly and to adhere the sticker assembly to a car window. As to the window being a windshield, note German '696's suggestion to releasably adhere the sticker assembly to a car window and optionally the admitted prior art's teaching that a vehicle windshield is a suitable vehicle window upon which to adhere a sticker. Claim 2 fails to require the vinyl film to be larger than the sticker. In other words, claim 2 reads on the edges of the film being in registry with the edges of the sticker.

Art Unit: 1733

As to claims 3 and 4, the limitation of using strips as set forth in claim 4 would have been obvious in view of (1) the admitted prior art's teaching that known stickers include temporary city stickers made from paper having a thin line of adhesive along the side of the sticker rather than a complete adhesive layer across the entire face of the sticker (page 18 lines 12-17) and (2) Langen's suggestion to removably secure a sticker to window using spaced strips having repositionable adhesive. See figures 2 and 3. The limitation of trimming as set forth in claim 3 would have been obvious in view of Langen's teaching to cut the strips so as to have the same length as the sticker.

As to claim 5, the limitation therein would have been obvious in view of German '696's suggestion to use a foil which is transparent.

As to claim 6, note examiner's comments on claim 1.

As to claim 7, the limitation therein would have been obvious in view of German '696's teaching to removably adhere a sticker to a window using a window sticker removal aid. German '696 is considered to suggest using a sticker and window sticker removal aid having the same size.

As to claim 8, note examiner's comments on claim 5.

As to claims 9 and 10, note examiner's comments on claim 4.

As to claim 11, note examiner's comments on claim 2. With respect to the adhesive layer having a strength such that the film cannot be separated from the adhesive without destroying the film and the sticker, note German '696 and optionally the admitted prior art's teaching to use a relatively strong adhesive for the sticker.

Art Unit: 1733

As to claim 12, note examiner's comments on claim 1. With respect to the adhesive layer having a strength such that the film cannot be separated from the adhesive without destroying the film and the sticker, note German '696 and optionally the admitted prior art's teaching to use a relatively strong adhesive for the sticker.

As to claims 13 and 14, note examiner's comments on claim 2. With respect to the adhesive layer having a strength such that the film cannot be separated from the adhesive without destroying the film and the sticker, note German '696 and optionally the admitted prior art's teaching to use a relatively strong adhesive for the sticker. The limitation of trimming the strips would have been obvious in view of Langen's teaching to cut the strips so as to have the same length as the sticker. See figure 1 and figure 2 of Langen.

10) Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Japan '014 (JP 9-97014) and optionally further in view of at least one the admitted prior art (specification pages 1-2), Great Britain '233 (GB 2174233) and Langen (US 5290067) as applied above and further in view of Gladden (US Statutory Invention Registration H46).

As to claims 3 and 7, it would have been obvious to trim the transparent film of German '696 as claimed since it is conventional in the bonding art to adhere two layers together and trim the edges of one of the layers so that the edges of the layers are in registry as evidenced for example by Gladden.

11) Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Japan '014 (JP 9-97014) and optionally

Art Unit: 1733

**further in view of at least one the admitted prior art (specification pages 1-2),
Great Britain '233 (GB 2174233) and Langen (US 5290067) as applied above and
further in view of Felchlin (US 4225369).**

As to claim 9, it would have been obvious to bond the sticker to the film using strips of adhesive since it is well known per se in the bonding art to bond two layers with adhesive such that the adhesive covers the entire layer or is provided in discrete layers as evidenced by Felchlin. Claim 9 fails to require strips of vinyl film. Claim 9 reads on a single vinyl film.

Langen

**12) Claims 1-4, 6-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Langen (US 5290067) in view of Honaker (US 4935288).**

Langen substantially discloses the claimed sticker assembly. See figure 2 and figure 3.

The claimed sticker reads on label 12, which has an "indicia bearing surface".

The claimed adhesive for attaching corresponds to permanent adhesive 35.

The claimed strips of vinyl film corresponds to strips 34 of label stock.

The claimed low tack adhesive reads on the repositionable adhesive 36.

Langen is silent as to the composition of the strips 34 of label stock.

As to claim 1 (sticker assembly), it would have been obvious to one of ordinary skill in the art to use vinyl film for the label stock used to form strips 34 since well known / conventional label stock includes vinyl label stock as evidenced for example by Honaker et al (col. 7 line 27). The limitation of the vinyl film being non-perforate would

Art Unit: 1733

have been obvious since Langen suggests using continuous uninterrupted non-perforate strips 34. As to the sticker assembly being adapted to be releasably adhered to a receiving surface, Langen teaches releasably adhering the sticker assembly to a window of a car.

As to claim 2 (method), the limitation of the film being continuous, uninterrupted would have been obvious since Langen suggests using continuous uninterrupted non-perforate strips 34. The step of adhering the sticker to the film via the adhesive layer would have been obvious in view of Langen's suggestion to adhere the strips 34 to the label 12 using permanent adhesive; it being well known / conventional per se in the bonding art to apply adhesive to either or both of the surfaces to be bonded. As to the sticker assembly being releasably adhered to a windshield of a vehicle, Langen suggests releasably adhering the sticker assembly to a window (e.g. a side window) of a car.

As to the remaining claims: As to claim 3, Langen suggests cutting the strips to correspond to the size of the label 12 (see figure 1 and discussion thereof). As to claim 4, Langen suggests using two strips 34. As to claim 6, Langen suggests using continuous uninterrupted non-perforate strips 34. As to claim 7, note registry of edges indicated by figure 2. As to claims 9 and 10, Langen suggests using two strips 34. As to claims 11 and 12, it would have been obvious to bond the strips 34 to the label 12 with an adhesive such that the strips 34 cannot be separated from the label without destroying the strips and the label in view of Langen's suggestion to bond the strips to the label with permanent adhesive. As to claims 13 and 14, it would have been obvious

Art Unit: 1733

to trim as claimed since Langen suggests cutting the strips to correspond to the size of the label 12 (see figure 1 and discussion thereof).

13) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14) Claims 15-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6258200.

Although the conflicting claims are not identical, they are not patentably distinct from each other because (1) claims 1-6 of US Patent 6258200 contain all of the limitations of claims 15-20 of this application and (2) claims 15-20 of this application do not exclude the remainder of the limitations of claims 1-6 of US Patent 6258200. For example: claim 15 of this application fails to exclude the indicia bearing portion of the sticker not having adhesive over that portion.

Art Unit: 1733

Allowable Subject Matter

15) Claim 18 would be allowable if (1) rewritten in independent form including all of the limitations of the base claim and any intervening claims and (2) the obvious type double patenting rejection is overcome by a proper terminal disclaimer.

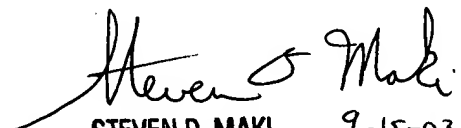
Although the use of spaced strips of adhesive is known per se as shown by Langen (US 5290067) and Travis (US4536423), there is no motivation to modify Great Britain '256 so as to include the step of placing strips of static-cling film coinciding with the strips of adhesive; it being noted that (a) Great Britain '256, which does not disclose using strips of static-cling film, teaches covering the entire surface of the vehicle window sticker (printed sheet) with the static cling film and (b) Great Britain '551, which also does not disclose using strips of static cling material, teaches using a single static cling sheet to define an edge margin of static cling material for a vehicle windshield sticker.

16) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is 703-308-2068. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Steven D. Maki
September 15, 2003


STEVEN D. MAKI
PRIMARY EXAMINER
~~GROUP 1300~~
Av 1733 9-15-03